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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,923	03/26/2001	Michael P. Caren	10981712-2	4359

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AGILENT TECHNOLOGIES, INC.
Legal Department, 51 UPD
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EXAMINER

SIEW, JEFFREY

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 11/01/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,923

Applicant(s)

CAREN ET AL.

Examiner

Jeffrey Siew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24 and 26-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24 and 26-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 9/10/02 for a Request for Continued Examination (RCE) under 37 CFR 114 is acceptable. An action on the RCE follows. The pending claims are 22-24 & 26-43.

Terminal Disclaimer

2. The terminal disclaimer filed on 9/10/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 09/150504 has been reviewed and is accepted. The terminal disclaimer has been recorded overcoming the double patenting obviousness rejection over 09/150504.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claims 22, 27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 7 of prior U.S. Patent No. 6,458,583 . This is a double patenting rejection.

Upon further review, the claims are indistinguishable. The response states that the claims of 09/150504 now US 6,458,583 are directed toward depositing nucleic acid onto a substrate surface to making an array and the instant claims are directed to a method of depositing nucleic acid material to an already made nucleic acid array. The instant claims would still read on the making of array because the nucleic acid may bind to a binding agent already on the array to immobilize the nucleic acid in the making the array of nucleic acids. The rejection is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22,23,26-31,34, 37 & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton (US 6,146,833 Feb. 11, 1997) over Deeg et al (US5,338,688 August 16, 1994).

Milton teach a method of depositing a quantity of fluid containing a nucleic acid onto a substrate array (Figure 7) having plurality of binding agents stably associated therewith comprising position a thermal inkjet (se abstract & col. 11 lines 8-10 teaching binding oligonucleotides to support activated with acyl fluoride functionalities & col. 12 lines 55-62 which explicitly teach using thermal inkjet printing techniques available in the art).

Milton et al do not explicitly teach actuating thermal inkjet head to expel.

Deeg et al teach a method of depositing biochemical analytical liquid such as containing a protein to a target using a jet from a jet chamber in which a partial volume of liquid in chamber is evaporated and expanded prior to ejection which would provide back pressure (see abstract & claim 1). The jet head contains a chamber and a jet orifice which is connected to reservoir (see Fig. 1). They teach that a Hewlett-Packard Quiet Jet plus ink-jet printing head which is thermal inkjet is used (see column 6 line 59). They teach forming a droplets in predetermined pattern (see claim 3). They also teach various reagents including wash solution. They teach that the device is used to bind biotinylated reagents to a surface coating containing streptavidin (see col. 5 line 49-51). They measure changes as result of reagent between sample and reagents (see claim 16).

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deposition of oligonucleotides to arrays. As the Milton explicitly states applying thermal inkjets, it would have been prima facie obvious to apply Deeg et al's thermal inkjet to deposit Milton et al's oligonucleotides to deposit large quantities to arrays.

The response previously stated that the prior art is not enabled for thermal inkjet application of oligonucleotides or nucleic acids. However, upon further review of the art, Milton et al's patent disclosure explicitly teaches using thermal inkjets to deposit nucleic acids. In light of the art, it would not be expected to be undue experimentation in using the thermal inkjet in the nucleic acid application.

5. Claims 24,32,33,35,36 & 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Milton (US 6,146,833 Feb. 11, 1997) over Deeg et al (US5,338,688 August 16, 1994) in further view of Cornell (US6,132,030 Oct. 17, 2000) .

The teaching of Milton and Deeg et al are described previously.

Milton et al do not teach uJ of heat..

Cornell teach the use of specific power requirements in determining the heat power density for ejecting from thermal inkjet.

One of ordinary skill would have been motivated to apply Cornell teaching of power to apply various heat power density to the combined invention of Milton and Deeg et al's inkjet device in order to optimize the ejection quality. Cornell states that controlling the heat increases quality by maximizing ink droplet velocity and increasing nucleation time (see col. 1 line 36- col. 2 line 5). It would have been prima facie obvious to use the Cornell teachings of the power

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heat variables to print quality to increase the quality of expelling in Milton et al's method of using thermal inkjet depositing.

SUMMARY

6. No claims allowed.

CONCLUSION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Siew whose telephone number is (703) 305-3886 and whose e-mail address is Jeffrey.Siew@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can best be reached on weekdays from 6:30 a.m. to 3 p.m. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703)-308-1119.

Any inquiry of a general nature, matching or filed papers or relating to the status of this application or proceeding should be directed to the Monica Graves for Art Unit 1637 whose telephone number is (703)-306-2938.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-3290 and Before Final FAX (703) 872-9306 or After Final FAX (703) 30872-9307.


JEFFREY SIEW
PRIMARY EXAMINER

October 28, 2002